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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,330	01/22/2001	Scott Thomas Molloy	14013-29US	9338

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EXAMINER

TON, ANTHONY T

ART UNIT PAPER NUMBER

2661

DATE MAILED: 04/22/2004

Handwritten mark resembling a stylized '7' or 'L'

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,330

Applicant(s)

MOLLOY, SCOTT THOMAS

Examiner

Anthony T Ton

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4 and 5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTIONS

Drawing Objections

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because the following:

a) reference character "90", which is used to label an e-mail/fax communication system 90 as described in page 14 lines 16 and 21 of the specification, is being missed in Fig.6.

Examiner suggests adding the character "90" into an appropriate place of the Fig.6.

b) reference character "220", which is used to label a networking environment 200 as described in page 14 line 17 of the specification, is being mislabeled in Fig.8.

Examiner suggests changing this character to "200".

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification Objections

2. The disclosure is objected to because of the following informalities:

a) Term "Fig. 4" in page 15 line 15 and in page 23 line 5 is not appropriate with the NASP 106 device 106 of Fig.6.

Examiner suggests changing this term to "Fig. 6".

b) Term "link 218" in page 25 line 25 is not appropriate with the link 216 as shown in Fig.8.

c) Term "the administration domain 220" in page 27 line 8, line 10 and line 12 is not appropriate with the term "networking environment 200" as shown in page 14 line 7 and in page 25 line 20.

Examiner suggests changing this term to "the networking environment 200".

Appropriate correction is required.

Claim Objections

3. **Claims 7, 11 and 17** are objected to because of the following informalities:

a) **In Claim 7:** term "Provider devices" in line 2 is not appropriate with the "Provider device" that was disclosed in line 1 of the instant claim since the term should be in singular form.

Examiner suggests changing this term to "Provider device".

b) **In Claim 11:** term "a digital communications links" in lines 2-3 is not appropriate since word "links" should be changed in singular form.

Examiner suggests changing this term to "a digital communications link".

c) **In Claim 17:** term "An method" in line 1 is not appropriate since the article "An" should be changed to "A".

Examiner suggests changing this term to "A method".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2661

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 2, 5-8, 10, 13-18 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry (US Patent No. 6,424,426).

a) **In Regarding to Claim 1: Henry disclosed an ARPA-Internet Network**

Access/Service provider device (*see Fig.1: block 5*) comprising:

a fax gateway (*see Fig.1: one of blocks 10 or block 8*) including,

a storage device for storing an e-mail message received from a sender through a data communications network, the stored e-mail message being converted to a fax document for transmission thereof to a fax recipient having access to a fax device (*see Fig.2: block 26 E-mail Server; the Server can be considered as a stored e-mail message storage device of the instant claim since it is used for email; and see col.7 lines 1-10: the email-to-fax gateway 66 in Fig.5 converts the MIME image into a text-formatted e.g. PostScript file. Then, the text-formatted file is rasterized into a fax encoded bit map image*);

at least one fax modem device for transmitting the fax document to the fax recipient through a public switched telephone network (*see Fig.2: blocks 20 fax Modem bank*),

Henry failed to explicitly teach wherein the ARPA-Internet Network

Access/Service Provider device allows a fax recipient to receive e-mail messages by the use of a fax device without requiring computer equipment.

However, Henry clearly disclosed an ARPA-Internet Network Access/Service Provider device that allows a fax recipient to send e-mail messages by the use of a fax device without requiring computer equipment (see Fig.3 and col.5 lines 3-15).

It was well known in the art that two-way communication is necessary for both sender and receiver to communicate, respectively. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such two-way communication to allow a fax recipient to receive e-mail messages by the use of a fax device without requiring computer equipment throughout the device, and allow a fax recipient to send e-mail messages by the use of a fax device without requiring computer equipment as taught by Henry, the motivation being to enable the apparatus in Henry to support two-way communication.

b) In Regarding to Claim 2: Henry disclosed all aspects of the claim 2 as set forth in Claim 1.

Henry failed to explicitly teach wherein the storage device further for storing a fax telephone number associated with the fax device of the fax recipient and for using the fax telephone number for establishing a call for the transmission of the fax document.

However, Henry disclosed a web server 88 connected to an IP router 82 in a network operation center as shown in Fig.7, wherein the web server 88 is used to capture and store the user's email address as well as the fax telephone number to which the user wishes to send the fax, and this fax telephone number is relayed over the Internet to the email server 26 (*considered as a stored email storage device of the*

instant claim) of the preferably nearest POP 10 to which the fax telephone number is associated (*see col.8 lines1-11*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such a web server 88, which can be connected to the IP router 32 in the device 10, as shown in Fig.2 of Henry for the purpose of reliably and automatically using in local calls because fax telephone number stored in the web server 88 is relayed over the Internet to the email server 26, the motivation being to reduce costs.

c) In Regarding to Claim 5: Henry further disclosed the storage device for further creating a fax cover page for transmission thereof to the fax recipient (see Fig.8A: step 114).

It would have been obvious to provide such a device for the same reason as in Claim 1.

d) In Regarding to Claim 6: Henry further disclosed wherein the e-mail message includes an e-mail address and the fax cover page includes a sender field extracted from the e-mail address (see Fig.4).

It would have been obvious to provide such a device for the same reason as in Claim 1.

e) In Regarding to Claim 7: Henry further disclosed wherein the Internet Network Access/Service Provider devices assigns an e-mail address to the fax recipient, the e-mail address being correlated to a fax telephone number identifying the fax device and wherein the fax cover page for further including a destination field

extracted from the fax recipient e-mail address (see col.1 lines 35-42: one type of service is that it requires the subscriber to have a specific telephone number associated with their email address; and see Fig.4: blocks 61 and 63 (destination field)).

It would have been obvious to provide such a device for the same reason as in Claim 1.

f) In Regarding to Claim 8: Henry further disclosed the Internet Network Access/Service Provider device for including the e-mail subject field contents in the fax cover page prior to transmission thereof to the fax recipient (see Fig.4: box of Freehand Notes and Drawings).

Henry failed to explicitly teach wherein the e-mail message includes a subject field. However, Henry disclosed a blank box for Freehand Notes and Drawings in Fig.4; by this box, it can be considered as both subject field and email subject contents because the subject field is just a blank line underneath the address field of an email message; before creating the contents of an email message, a fax sender can create the subject of the email message at the first line on the top of such a box.

Therefore, it would have been an obvious matter of design choice to provide such a subject field throughout the last "Cc:" field as shown in Fig.4 of Henry in order to the email format used by fax user can be the same as that of Internet emails, the motivation being to perform equally well with the regular emails.

g) In Regarding to Claim 10: Henry further disclosed wherein the fax gateway is coupled to the public switching telephone network through one or more telephone lines (see block POTS in Fig.1 and B1 lines in Fig.2).

It would have been obvious to provide such a device for the same reason as in Claim 1.

h) In Regarding to Claim 13: Henry further disclosed wherein the storage device is a computer system having a conversion program for causing conversion of the e-mail message to a fax document (see Fig.5 and col.5 line 2-37: software architecture).

It would have been obvious to provide such a device for the same reason as in Claim 1.

i) In Regarding to Claim 14: Henry further disclosed wherein the storage device is a computer system having an e-mail program for causing storage of the e-mail message (see col.6 line 34-50: SMTP protocol and software architecture).

It would have been obvious to provide such a device for the same reason as in Claim 1.

j) In Regarding to Claim 15: Henry further disclosed wherein the e-mail program and the conversion program reside externally to the fax gateway (see col.6 lines 44-50: all software modules could reside on a single server or on a different servers than is shown in the embodiment of Fig.5).

It would have been obvious to provide such a device for the same reason as in Claim 1.

k) In Regarding to Claim 16: Henry further disclosed wherein the fax gateway further for receiving a reply fax document from the fax recipient, for converting the reply fax document to a reply e-mail message and for transmitting the reply e-mail message to the sender (see Fig.8B: steps 120-126).

It would have been obvious to provide such a device for the same reason as in Claim 1.

l) In Regarding to Claims 17 and 18: These claims are rejected for the same reasons as claims 1 and 16, respectively because the apparatus in claims 1 and 16 can be used to practice the method steps of claims 17 and 18, respectively.

m) In Regarding to Claim 21: Henry disclosed a method for sending and receiving e-mail messages using a fax device as recited in Claim 17. This method can be applied to reject this claim for the same reasons as claim 17 because it is well known in the art that method steps can be programmed to automate a process. The resulting program is considered as firmware that the apparatus uses to perform the method steps.

It would have been obvious to include in Henry this well-known art, the **motivation being** to make Henry's fax device operate automatically.

6. **Claims 19 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry (US Patent No. 6,424,426) in view of Toyoda et al (provided by IDS #5) (US Patent No. 5,812,278).

Henry disclosed all aspects of Claims 19 and 20 as set forth in the Claim 17.

Henry failed to explicitly teach further including the step of verifying a destination user address for identifying the fax recipient as being a known user as recited in **Claim 19**; and upon unsuccessful verification of the destination user address sending a failed message as recited in **Claim 20**.

Toyoda et al disclosed such verifying a destination user address and upon unsuccessful verification of the destination user address sending a failed message (see Fig.29: steps 233, 241 and 244).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such verifying a destination user address and upon unsuccessful verification of the destination user address sending a failed message throughout the fax-to-email and email-to-fax communication system of Henry, as taught by **Toyoda et al** for the purpose of notifying the sender that he/she has a wrong address of the destination and save bandwidth of transmitted, the motivation being to make Henry more efficient.

7. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Henry (US Patent No. 6,424,426) in view of **Owens et al** (US Patent No. 6,633,630).

Henry disclosed all aspects of Claim 9 as set forth in the Claim 1.

Henry failed to teach wherein the storage device for further assigning a mailbox for storage of e-mail messages directed to the fax recipient and upon receipt of the e-mail message, for storing the e-mail message within the assigned mailbox of the fax recipient. **Owens et al disclosed** such a mailbox (see col.2 lines 23-43: universal mailbox).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such a mailbox throughout the fax spooler and email server of Henry as taught by **Owens et al** so that all different messages in

different media such as email, voice mail and fax mail can be stored in a universal mailbox, **the motivation being** to provide capabilities for same-media and cross-media notification and responses.

8. **Claims 11 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Henry** (US Patent No. 6,424,426) in view of **Gidwani** (US Patent No. 6,640,239).

Henry disclosed all aspects of Claims 11 and 12 as set forth in the Claim 1; and **Henry further disclosed** wherein the fax gateway is coupled to the data communications network (*see Fig.1: blocks of Internet and POP1*).

Henry failed to teach wherein the fax gateway is coupled to the public switching telephone network through a digital communications link; and wherein the fax gateway is coupled to the data communications network through a digital communications link.

Gidwani disclosed such a digital communications link (*see Fig.2: DSL*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such a digital communications link throughout the Internet access lines e.g., T-1 or T-3 of Henry, as taught by **Gidwani** for the purpose of multiple services such as voice, data, video and signaling, **the motivation being** to make Henry more efficient.

9. **Claims 3 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Henry** (US Patent No. 6,424,426) in view of **Toyoda et al** (US Patent No. 5,825,505).

Henry disclosed all aspects of Claims 3 and 4 as set forth in the Claim 1.

Henry failed to explicitly teach wherein the storage device for further storing a time-of-day for specifying a range of time during which the fax document is transmitted; and the storage device further for storing a fax telephone number associated with the fax device of the fax recipient and for using the fax telephone number for establishing a call for the transmission of the fax document.

Toyoda et al disclosed such storing a time-of-day for specifying a range of time during which the fax document is transmitted (see Fig.12: steps 65-71).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such a digital communications link throughout the fax-to-email and email-to-fax communication system of Henry, as taught by Toyoda et al for the purpose of controlling the time of a fax document that is transmitted throughout communication systems, the motivation being to make Henry more efficient.

However, Henry disclosed a web server 88 connected to an IP router 82 in a network operation center as shown in Fig.7, wherein the web server 88 is used to capture and store the user's email address as well as the fax telephone number to which the user wishes to send the fax, and this fax telephone number is relayed over the Internet to the email server 26 (*considered as a stored email storage device of the instant claim*) of the preferably nearest POP 10 to which the fax telephone number is associated (*see col.8 lines1-11*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such a web server 88, which can be

connected to the IP router 32 in the device 10, as shown in Fig.2 of Henry for the purpose of reliably and automatically using in local calls because fax telephone number stored in the web server 88 is relayed over the Internet to the email server 26, the motivation being to reduce costs.

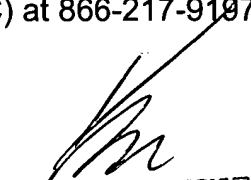
Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony T Ton whose telephone number is 703-305-8956. The examiner can normally be reached on M-F: 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas W Olms can be reached on 703-305-4703. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ATT
4/19/2004


KENNETH VANDERPUYE
PRIMARY EXAMINER